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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/350,297

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SHIBATA

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QM12/0713

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EXAMINER

RACHUBA, M

ART UNIT

PAPER NUMBER

3724

DATE MAILED:

07/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/350,297

Applicant(s)

SHIBATA ET AL.

Examiner

M Rachuba

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-59 is/are pending in the application.
- 4a) Of the above claim(s) 26, 39, 45, 53 and 55-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-25, 27-38, 40-44, 46-52 and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 17-59 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12, 13.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly added claims 26, 39, 45, 53, and 55-59 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 26, 39, 45 and 53 are directed to a patentably distinct species different than those originally presented and acted on, the species being directed to a battery case with lid and hinge. Further, claims 56-59 are also directed to a patentably distinct species different than those originally presented and acted on, the species being directed to a battery mounting device disposed *within* the side surface of the auxiliary table, and the various mounting positions on the table.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26, 39, 45, 53, and 56-59 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 18, 20, 24, 32, and 37 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 17 and 34 limit the battery mounting device to being disposed at or on the rear portion of the blade case.

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Claims 18, 20, 24, 32 and 37 all then further limit the battery mounting device to being mounted on a handle which is mounted on the blade case. It is not clear what structure is being claimed.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 47 and 49 are finally rejected under 35 U.S.C. 102(b) as being clearly anticipated by the advertisement, Glass Magazine, August 1998 (hereafter referred to as DeGorter Ad). DeGorter Ad clearly discloses a table saw comprising a table adapted to support a workpiece, a saw unit disposed above the table and pivotable with respect to the table about a pivotal axis, the saw unit comprising a saw blade and a handle and a battery mounting device disposed on the handle and above the pivotal axis. See marked up copy of ad, attached.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 17-25, 27, 28, 30-38, 41-44, 48, and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the device disclosed by the DeGorter Ad. The DeGorter Ad shows a device which shows everything claimed except the position of the battery mounting device and handle being at the rear of the blade case, does not explicitly show a switch on the handle to activate the motor, or a belt drive between the motor and the saw blade to transmit rotary power from the motor to the blade. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have changed the location of the battery mounting device and battery of the device disclosed by the DeGorter Ad from the front of the blade case to the rear of the blade case, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. As regards the switch on the handle, or the belt drive between the motor and saw blade, the examiner takes Official notice of the common use of switches placed on handles, for ease of operation, and of belt drives, to transmit power from a motor to a tool, where the motor may be displaced

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from the axis of the tool. It would have been obvious to one of ordinary skill at the time of the invention to have provided the device shown by the DeGorter Ad with a motor activating switch and belt drive, to ease operation of the saw.

9. Claims 29, 40, 46 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over the device shown in the DeGorter Ad in view of Moll, 945. The device shown in the DeGorter Ad shows everything claimed except an opening in the battery case to discharge particles. Moll teaches the use of a battery case which has openings to vent gases from the case, to prevent damage to the battery, tool and operator. It would have been obvious to one of ordinary skill to have provided the device shown by the DeGorter Ad with an opening in the battery case as taught by Moll, figure 1. The fact that applicant has recognized another advantage (removal of particles) which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 17-25, 27-38, 40-44, 46-52, and 54 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning the content of this communication or earlier communications from the examiner should be directed to M. Rachuba whose telephone number is (703) 308-1361. The examiner can normally be reached on Monday through Friday from 8:30 AM to 3:00 PM. Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Representative, Tech Center 3700, (703) 306-5648.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at (703) 305-3579. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO

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deposit account. Please identify Examiner Rachuba of Art Unit 3724 at the top of your cover sheet.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

M. RACHUBA  
PRIMARY PATENT EXAMINER  
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A handwritten signature in black ink, appearing to be 'M. Rachuba', is written over the printed name and title.

mtr  
July 11, 2001